



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,726	07/03/2003	Rudiger Gorny	PO7743/LcA 35,548	7274

157 7590 12/29/2004

BAYER MATERIAL SCIENCE LLC
100 BAYER ROAD
PITTSBURGH, PA 15205

EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
----------	--------------

1712

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,726

Applicant(s)

GORN Y ET AL.

Examiner

David Buttner

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Art Unit: 1712

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The formulas (I) and (II) are not polycarbonates. The structures are believed to be termed "peroxycarbonates".

It is not clear how "coex" limits claim 1,6 and 8.

Claim 8's "claims 1 to 7 Claim 1" is not understood.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

Art Unit: 1712

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2,5 and 8 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over J05339390.

The reference discloses copolycarbonate films of bisphenol A and dihydroxybiphenyl. Oral translation indicates laminates are suggested (paragraph 1).

Claims 1,2,5 and 8 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over J2000280414.

The reference discloses laminates of a polycarbonate layer with a polycarbonate-siloxane layer. The chemical abstract indicates registry # 28902-22-9 is used as the polycarbonate layer. This registry # corresponds to bisphenol A/ dihydroxybiphenyl copolymer.

Claims 1,2,5 and 8 rejected under 35 U.S.C. 102(a,b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DE 10047483.

US6586556 is relied on as a translation.

The reference exemplifies (#1) applicant's preferred polycarbonate copolymer. This polycarbonate can be used coextruded sheets, composite films etc (col 5 line 56-63).

Claims 1,2 and 5-8 rejected under 35 U.S.C. 103(a) as being unpatentable over DE10047483 in view of Sakashita '324.

DE10047483 suggests UV stabilizers can be added (col 6 line 25), but specific amounts and species are not named.

Sakashita (col 11 line 61) names one of applicant's preferred UV stabilizers for use in the same polycarbonate. It would have been obvious to use any known UV stabilizer in the conventional amounts for the expected advantages in the DE10047483 laminate.

Claims 1-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Lower '659 in view of Sakashita '324 or DE10047483 or J05339390.

Lower discloses multilayer polycarbonate sheets (abstract). UV absorbers can be included (col 9 line 37). The polycarbonates can be copolycarbonates (col 3 line 55). Preferred phenols include dihydroxydiphenyl (col 3 line 22) and bisphenol A (col 3 line 38). Lower does not specifically teach a copolycarbonate of the these two phenols.

Sakashita (abstract), DE10047483 (abstract) and J05339390 all teach the advantages of bisphenol A/dihydroxybiphenyl copolycarbonates. It would have been obvious to select this particular copolycarbonate from Lower's possibilities for the improved chemical resistance etc.

Claims 1-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Anders CA 2297244 in view of Sakashita '324 or DE10047483 or J05339390.

Anders exemplifies multilayer polycarbonate sheets containing UV absorbers (table). The polycarbonates can be copolycarbonates (page 7 line 21). Preferred phenols include dihydroxydiphenyl (page 6 line 28) and bisphenol A (page 7 line 8). Ander does not specifically teach a copolycarbonate of the these two phenols.

Sakashita (abstract), DE10047483 (abstract) and J05339390 all teach the advantages of bisphenol A/dihydroxybiphenyl copolycarbonates. It would have been

obvious to select this particular copolycarbonate from Ander's possibilities for the improved chemical resistance etc.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID J. BUTTNER
PRIMARY EXAMINER

David Buttner

12/21/04

